

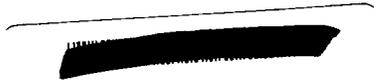
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RACETRAC PETROLEUM, INC., )  
 )  
 Opposer, )  
 )  
 v. )  
 )  
 ETW CORPORATION, )  
 )  
 Applicant. )

Opposition No. 117,623

Trademark: RACEWAY and  
Design, Serial No. 75/321,745



07-21-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

**OPPOSER'S BRIEF**

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**DESCRIPTION OF THE RECORD**

1. Testimony in Deposition of Jeffrey Hassman, taken March 27, 2002, and Exhibits thereto.
  
2. Opposer's Notice of Reliance, filed March 29, 2002, and attached Status copies.

07/01/2008TTAS

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

RACETRAC PETROLEUM, INC.,	)	
	)	
Opposer,	)	Opposition No. 117,623
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v.	)	Trademark: RACEWAY and
	)	Design, Serial No. 75/321,745
ETW CORPORATION,	)	
	)	
Applicant.	)	

**OPPOSER'S BRIEF**

**ISSUE PRESENTED**

Whether registration and use of the Applicant's mark RACEWAY and design, subject of United States Patent and Trademark Office application no. 75/321,745 should be barred by Section 2(d) of the Lanham Act based upon Opposer's prior rights in the mark Raceway for use in association with related services and products.

**I. Introduction**

Opposer, RaceTrac Petroleum, Inc. has a long history of growth and innovation in the gasoline station and convenience store industry. It began doing business in the 1930's under another name, and by 1967 it had developed the Raceway mark and service station concept. Ronald Hassman Testimony p. 8, (hereinafter Hassman 8). The Raceway service station concept consists of high-volume, full-service gasoline stations typified by a long center island where an attendant can maximize the number of vehicles fueled and serviced. The Opposer has long positioned Raceway to stand for high volume gasoline at low prices. Opposer's Ex. 1. Raceway stores serve a broad demographic of local and transient retail automotive customers and its

customers also include industrial customers, such as truckers, bus drivers and commercial carriers.  
Hassman 24, 33.

Opposer owns a number of United States Patent and Trademark Office registrations of the mark Raceway, namely Registration No. 1,784,457, issued July 27, 1993, existing and incontestable, to cover Automobile Filling Station Services; Raceway (Stylized), Registration No. 2,350,123, registered May 16, 2000, and existing to cover Retail Convenience Store Services and Automobile Filling Station Services; Raceway, Registration No. 2,288,357, registered October 26, 1999, and existing to cover Convenience Store Services; and Raceway, Registration No. 13136548, existing and incontestable, to cover Motor Oil. Opposer's Notice of Reliance and Exhibits thereto.

Use of the mark Raceway in association with the above-described goods and services has been continuous since its adoption in 1967. Hassman 10. Opposer operates today both RaceTrac and Raceway gasoline service stations and associated convenience stores, and as of 1999 there were over 500 RaceTrac stores enjoying over \$2 billion in sales annually. Hassman Exs. 1 and 2. Opposer operates about 140 Raceway stores now and there are plans currently underway for expanding that number on an average of five to ten more a year. Hassman 19-20. Raceway stores accounted for over \$240 million in sales in 2001, and that was up about \$35 million from the year before. This is a reflection of Opposer's commitment to, and the hearty growth curve of, the Raceway concept. Raceway stations generally operate in the southeast region of the country from Texas north to Kentucky and down throughout Florida: in all, in about 12-13 states. Hassman 18-19.

The Raceway concept, and the stations and stores that exemplify it, is highly valued by Opposer and Opposer is intent on continuing and building that brand and model successfully. Hassman, 7. The Raceway brand is undergoing extensive re-imaging, and from 1999 to March

2002, Opposer had spent in excess of \$1.5 Million to re-image the stations and stores. It intends to spend even more to re-image and build new Raceway stores. Hassman 11. An example of the exterior appearance of a Raceway store appears on Hassman Ex. 6, and of Opposer's signage for the same on Hassman Ex. 7. At the present time, the only branded Raceway product is motor oil, which is sold within Opposer's stores. Nevertheless, as further evidence of the Opposer's commitment to the Raceway brand Opposer indicates that, in keeping with the current trend of bringing store brands into the products those stores sell, it intends to leverage the Raceway brand into more of the products sold within the Raceway stores. Hassman 29, 21-22. Opposer has indicated that in fact that is how you "monetize" such a brand. Hassman 23. In other words, Opposer believes in the brand equity it enjoys in the mark Raceway, and is now and will continue to seek to exhibit and exploit the brand through innovation and branding of products. Such an approach is considered by Opposer to be a natural "extension" of its business. Hassman 29. At present, Opposer believes that if its customers saw "Raceway branded tools, especially automobile repair tools, and they were familiar with [Opposer's] Raceway gas and convenience stores they would expect that those tools were in some way affiliated if [they] did not come from the Raceway stores." Hassman 22.

Opposer is considered to be in the forefront of its industry in terms of design, marketing and location and its convenience stores, operated in conjunction with its gasoline stations, are known to contain the newest concepts in the industry such as daily-fresh delis, fast food, video rentals and pay at the pump. Hassman Ex. 2. "All of the Raceway and RaceTrac stores operate in the same way; that is, the convenience stores associated with the gasoline filling stations carry such things as groceries, snacks and other matter associated with a filling station, such as oil, automotive repair and maintenance materials such as wrenches, screwdrivers, tool sets, windshield wipers, and

antifreeze, and...things that people would expect to buy in a place where they can get gasoline."

Hassman 12 and 13. The public's expectations are justifiable given that they do not find such products in convenience stores, and these include handheld gauges, such as tire pressure gauges and automotive tool sets. Hassman 27, 34. People also expect to receive certain automotive-related services from their gasoline stations, including minor auto repairs, and at Opposer's facilities people come in to check their oil, replace lights, replace windshield wipers and to do related automotive maintenance tasks. Hassman 18.

Both RaceTrac and Raceway stores, at certain periods in their history prior to 1995 and continuing to today, have had displayed on their signage a checkered flag design. Hassman 35. There is a high probability that current Raceway stations and stores carry a checkered design along with the word Raceway, since the checkered flag has, historically, been used at Raceway stations and not all the Raceway stores have been re-imaged to date. Hassman 15. There are currently sister and subsisting RaceTrac stores with the checkered flag design on them. See Hassman 15, "I know for a fact there are RaceTracs out there with a checkered flag on them." There is a high probability that the checkered flag is also used in association with the Raceway stores. Hassman 14.

On July 9, 1997 Applicant, ETW Corporation filed application Serial No. 75/321745 for the mark shown below,



to cover:

STACI, COURTNEY

Air powered tools, namely, paint guns, pop riveters, drills, impact wrenches, ratchet wrenches, grinders, sanders and cut-off tools; replacement parts for the above specified air tools; hydraulic pop riveters in International Class 7;

Hand-tools, namely, bolt cutters; hammer and dolly sets comprised of hammers of varying sizes and dollies; hammers sold in sets of varying sizes; punches and chisels sold in sets of varying sizes; pry bars sold in sets of varying sizes; wrenches sold in sets of varying sizes; sockets sold in sets of varying sizes; pliers sold in sets of varying sizes; screwdrivers sold in sets of varying sizes; files sold in sets of varying sizes; specialty hand-tools, namely, chisels, taps and dies, hammers punches, scrapers, screwdrivers, socket sets sold in sets of varying sizes and wrenches for use in body, engine brake and undercar repair in International Class 8;

Hand-held diagnostic equipment for motor vehicle, namely, multi-meters, timing lights, battery testers, and compression testers in International Class 9;

Air hoses for pneumatic tools in International Class 17;

Tool chests and tool roll cabinets in International Class 20, and

Mobile tool carts and mobile stands for dispensing masking paper and tape in International Class 12.

The Applicant's goods to be covered by the Raceway mark are best summarized as "[a] lot of automobile repair kinds of tools, dispenser and chests, [and] airhoses." Hassman 21. The goods include the same kinds of products that one can find in a Raceway store (e.g. handheld gauges). Hassman 27.

Use of the mark Raceway by Applicant is alleged to be as of 1995; however, Applicant has not placed into the record any evidence of its use, nor has it indicated the geographical or sales scope of its use. In fact, Applicant has placed nothing into evidence, nor did Applicant ever respond to a series of discovery requests made by Opposer, even after repeated requests and finally, a Motion to Compel.<sup>1</sup>

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<sup>1</sup> Filed late based upon Applicant's assurances that the answers were forthcoming and then denied due to its untimely filing.

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## II. SUMMARY OF ARGUMENT

Opposer has long-established trademark rights in and to the mark Raceway for use in association with automobile service stations, convenience store services, certain automotive or automotive repair products sold therein, and good reasonably related thereto.<sup>2</sup> Applicant seeks herein to register the identical mark Raceway for use in association with a very broad line of automotive repair tools and equipment. Opposer's position is that Applicant's automotive tools are of a type typically used, and or sold, in an automotive service station or its related convenience store, and that Applicant's goods are identical to, or so related to, Opposer's goods and services that the relevant purchasing public would expect to find such goods sold through or used by Opposer's services. Accordingly, Applicant's use of the Raceway mark on the goods described is likely to cause customers to be confused into the belief that Applicant's goods are sponsored by, emanate from, are licensed by Opposer, or that Applicant is in some way affiliated with the Opposer.

## III. ARGUMENT

### A. Priority

Priority is not in dispute. Opposer's use of the mark Raceway and its use of a checkered flag in association therewith both began much prior to 1995, the date of first use alleged, but not proven, by the Applicant herein. Opposer's use of its mark Raceway in block, and in stylized form, has been continuous from its date of first use. Hassman 10. Opposer has placed into evidence under a Notice of Reliance, filed March 29, 2002, status and title copies of its registrations of Raceway, Registration No. 1784457, Registration No. 2288357, Registration No. 1136548, and

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<sup>2</sup> Under the related goods doctrine, "Protection extends to products which might be reasonably thought to originate from the same service." King Research, Inc., v. Shulter, Inc., 324 F. Supp. 631, 169 U.S.P.Q. 396 (S.D.N.Y. 1971), aff'd 454 F. 2d 66, 172 U.S.P.Q. 321 (2d Cir. 1972).

Raceway Stylized, Registration No. 2350123. Applicant has not placed into the record any evidence of use, merely claiming, but not proving, a 1995 use date in its application file. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

**B. Likelihood of Confusion**

Opposer is entitled to judgment under 15 U.S. C. § 1052 (d) because Applicant's mark is likely to be confused with Opposer's Raceway mark. Under the test set forth in E.I. Du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C. C. P.A.), the following nonexclusive factors warrant consideration in any determination of the likelihood of confusion between two marks:

1. **The Degree of Similarity Between The Parties' Marks**

The word portion of Opposer's and Applicant's marks are identical in pronunciation, meaning and appearance. The addition of a checkered flag design to Applicant's mark does nothing to dispel confusion because the identical word with the identical meaning, Raceway, dominates each of the respective marks. In fact, reference to Exhibits 4 and 7 indicates that both parties also give emphasis to the components of the word Raceway, by emphasizing the "W" as it appears therein. While there is no per se rule that indicates that with respect to marks comprised of a word and design the word portion of the mark dominates, surely, in this case the word portion does dominate, as "It has been stated that in a word-design composite mark, the words are always presumed to be the 'dominant' portion." J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 23.47. The marks at issue would be referenced by the word portion, which is simply reinforced by the presence of the checkered flag which is itself synonymous with racing. Further, any differences in the typestyle of Applicant's mark and Opposer's mark is not relevant because some of Opposer's registrations are in typed form, and thus its use of the mark Raceway is

not limited to any special form. Squirtco V. Tomy Corp. 697 F.2d 103, 1041, 216 U.S.P.Q. 937, 939 (Fed. Cir. 1983); Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 U.S.P.Q.2d 1842, 1847-48 (Fed. Cir. 2000).

Additionally, Opposer has since a date earlier than Applicant used a checkered flag in association with its mark Raceway, and in all probability still uses the checkered flag design in connection with some of its stations. Hassman 15. Accordingly, the use by the Applicant of a checkered flag in association with the word mark Raceway is only likely to escalate and enhance the confusion its usage of this mark is certain to create. The identical nature of the marks makes it likely that the overall impression in the marketplace created by use of Applicant's Raceway and Design mark will be the same as that created by use of the Opposer's mark Raceway. See, e.g., Maine Savings Bank v. First Bank Group of Ohio, Inc., 220 U.S.P.Q. 736 (T.T.A.B. 1983) (finding likelihood of confusion on basis of similarity between dominant elements of marks).

Because the marks are identical or so similar as to be indistinguishable, they create the same commercial impression, and application of this duPont factor weighs heavily in favor of a finding of a likelihood of confusion. See Seven-Up Co. v. Aaron, 216 U.S.P.Q. 807, 810 (T.T.A.B.)

## **2. The Relatedness of the Parties' Goods and Services**

Confusion is also likely because the parties' goods and services are highly related, and will be thought to emanate from or be sponsored by the same source.<sup>3</sup> Opposer's mark Raceway is used in association with gasoline filling stations and related convenience store services and on motor oils for vehicles. Hassman 10. Applicant seeks to register its mark to cover a number of goods, all of which might be best described as automotive repair tools, and which would be expected to be

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<sup>3</sup> It has long been established that a mark will be protected on any goods that buyers would be likely to think came from the same source as another's services or goods. Aunt Jemima Mills Co. v. Rigney & Co., 247 F. 407 (2d Cir 1917), cert. denied, 245 U.S. 672, 38 S. Ct. 222 (1918)

found at a gasoline filling station by the general public, and by such commercial or industrial users as truck drivers, bus drivers and commercial carriers. Hassman 12, 13. Certain of the products described within the Applicant's specification of goods are identical to and fall directly within those categories of products sold through Opposer's Raceway stations. Hassman 13, 34. Because it is apparent that at a minimum, certain of the goods sold by Applicant under the mark Raceway are identical to the goods sold by Opposer in its Raceway stations, and all of the goods are related to automotive care, there is sufficient overlap in the respective goods and services as to find that this factor weighs in favor of a finding of a likelihood of confusion. See Phillips Petroleum Co. v. C.J. Webb, Inc., 442 F. 2d 1376, 170 U.S.P.Q. 35 (CCPA 1971) (For "CRC Marine Formula 66," rust and corrosion inhibitor for boats, confusingly similar to mark "66" for non-identical marina services and supplies.) Even if all of these factors were not so, Opposer is entitled to protection against use of its mark on any product that would reasonably be thought by the buying public to come from the same source, or be thought to be affiliated with, connected with, or sponsored by Opposer. Standard Brands, Inc. v. Smidler, 151 F.2d54, 66 U.S.P.Q. 337 (2d Cir 1945).

3. **Overlap Between the Parties' Customers and Channels of Distribution**

Applicant has not limited the distribution channels for its goods in its application and Applicant submitted no evidence to show that its distribution channels are limited; accordingly, since Applicant's goods are all automotive maintenance and repair goods, one may presume an overlap in Opposer's and Applicant's customers and channels of trade. See Octocom Sys. v. Houston Computer Servs., 918 F. 2d 937, 942, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990) (holding that where registration's recitation of goods is unrestricted, evidence that might be presented by owner of mark as to the particular channels of trade or class of purchasers is irrelevant); see also In re Epic Sys. Corp., 228 U.S.P.Q. 213 (T.T.A.B. 1985).

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In this case, Opposer has shown that its outlets are exactly those kind of outlets that do distribute automotive repair tools, Hassman 12, 13, and, even more importantly, that it is precisely the Opposer's service stations and convenience stores to which a customer might reasonably come seeking to buy, or even to use on-site, automotive repair equipment and tools. Hassman 18. Accordingly, the overlap in customers and channels of trade has been proven by Opposer and has not been disputed, nor can it be disputed, by Applicant. This factor weighs in favor of a finding of likelihood of confusion.

4. **The Conditions Under Which the Parties' Respective Goods And Services Are Sold**

Because there is nothing in the record to limit Applicant's channels of trade or to indicate that Applicant's goods are "high end" or have any other characteristic or quality to cause one to believe that they would be items of purchase for the highly discriminating and sophisticated purchaser, Opposer submits that they are likely to be sold to customers of Opposer's facilities. Because Applicant's goods are items which are likely to be found, and are expected by the public to be found, in Opposer's gasoline and convenience store service facilities, Hassman 12, 13, Opposer submits that its customers are the very ones to whom Applicant's goods are likely to be sold. Additionally, Applicant's products may very well be bought hastily and without great attention to their quality. Boston Athletic Assn. v. Sullivan, 867 F. 2d 22, 30, 9 U.S.P.Q. 2d 1690, 1697 (1<sup>st</sup> Cir. 1989). Opposer's products and services are by their nature mid-price products bought by persons expected to fill their automobiles and make the occasional convenience store purchase. Convenience stores are notable for the fact that, as associated with gasoline service stations, their customers are people who are "on the road" and are therefore not the type of people to agonize for a lengthy period of time over a buying decision. Consequently, the conditions under which the

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parties' respective goods and services are sold weighs in favor of a finding of likelihood of confusion.

**5. The Degree of Interaction Between the Parties:**

Under du Pont, a senior user's consent to, or acquiescence in, the use of the junior party's mark may reduce the likelihood of confusion between the two; here, however, there is no indication that Opposer ever knew of Applicant's use of the mark (if indeed any use is being made), nor, as these proceedings make clear, is it willing to consent to Applicant's attempt to register the mark.

**6. The Extent of Actual Confusion:**

An absence of any showing of actual confusion between marks is of little, if any, probative value where there is a lack of evidence as to the extent of the applicant's use of its mark. See, e.g., Nina Ricci S.A.R.L. v. E.F.T. Enters., 889 F.2d 1070, 1073, 12 U.S.P.Q.2d 1901, 1903 (Fed. Cir. 1989); see also U.S. Cycle Corp. v. Tire & Battery Corp., 12 U.S.P.Q. 2d 1021, 1023 (T.T.A.B. 1983) ("[L]ack of evidence of actual confusion does not preclude a finding of actual confusion."). This rule is particularly appropriate where, as here, there is no evidence that the challenged mark ever has been used in commerce in the United States.

**7. Summary of the Relevant Factors:**

Each of the duPont factors for which there is record evidence favors a finding that confusion is likely. Accordingly, Opposer herein respectfully requests the Board to enter judgment in the Opposer's favor under Section 2 (d).

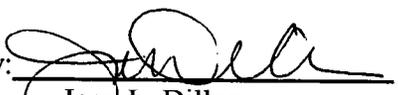
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**8. Conclusion:**

For the reasons set forth above, Opposer, Racetrac Petroleum, Inc. respectfully requests the Board to deny registration to Applicant's mark.

Respectfully submitted,  
RaceTrac Petroleum, Inc.

July 15, 2003

By: 

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22202-3513 On 7-15-03  
  
Signature

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ETW CORPORATION,	)	
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Applicant.	)	

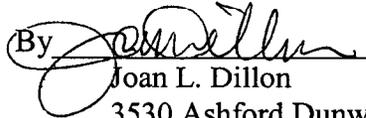
**CERTIFICATE OF SERVICE**

This is to certify that I have on this date served a copy of the foregoing Opposer's Brief on Applicant's counsel by first-class mail, postage prepaid, addressed as follows:

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This 15<sup>th</sup> day of July, 2003.

Respectfully submitted,  
JOAN DILLON LAW, LLC

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